

Notice of Allowability

Application No.

09/751,025

Examiner

David M Brunzman

Applicant(s)

HUBBS, JONATHAN W.

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the appeal brief filed 13 May 2004.
2. ☒ The allowed claim(s) is/are 1-38 and 41-46.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

David M Brunzman
Primary Examiner
Art Unit: 1755

Applicants' appeal brief has been received. In view of the arguments set forth therein, the outstanding final rejection has been withdrawn and prosecution reopened.

The following is an examiner's statement of reasons for allowance: The instant claims are directed to a invention including "a material [that] is a mixture of wax and clay" (Appeal Brief page 3, lines 1-2). The wax is recited in each of the independent instant claims as being of a type "to make the surface material malleable" and "to add cohesiveness between the particles". The instant specification clearly indicates that not just any wax would work. Page 8, line 8 of the Appeal Brief confirms "not all waxes will work in the invention". The specification and repeated assertions in applicant's responses establish that waxes falling within the scope of "of a type to make the surface material malleable and to add cohesiveness between the particles" are required by the instant invention as claimed. This limitation must be construed in light of 35 U.S.C. 112(6). As set forth at MPEP 2162 Section II, such a claim limitation is adequately described under 112(1) if "the written description adequately links or associates adequately described particular [materials] to the function recited" or if it is clear "one skilled in the art would have known what [materials] perform the function recited". See *In re Noll*, 191 USPQ 721. The lack of traditional "means for" or "step for" language does not prevent a limitation from being viewed in light of 112(6). *Signtech USA, Ltd. V. Vutek, Inc.*, 50 USPQ2d 1372. Claim limitations such as "reducing the coefficient of friction of the resulting film" *In re Roberts*, 176 USPQ 313 and, "raising the pH of the resultant pulp" *Ex Parte Zimmerley*, 153 USPQ 367, have been determined as invoking 112(6). The limitations "to make the surface material malleable" and "to add cohesiveness between the particles" must invoke 112(6) as well. The instant claims are construed in their broadest reasonable interpretation as including all corresponding materials described in the specification and their equivalents. See, *Kemco Sales, Inc. v. Control Papers Company*, 54 USPQ2d 1308. The factors to be considered in

Art Unit: 1755

deciding the scope of equivalents within this arena are set forth at MPEP 2183 and 2184.

The rejection over prior art is withdrawn as not teaching the limitation to the waxes as of a type "to make the surface material malleable" and "to add cohesiveness between the particles".

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David M Brunsman
Primary Examiner
Art Unit 1755

DMB

